

## **REMARKS**

By this amendment, claims 2, 4, 5 and 6 have been canceled. Claims 1 and 7 have been amended. Claims 1, 3 and 7-11 remain in the application. Support for the amendments to the claim can be found the specification and drawings. No new matter has been added. This application has been carefully considered in connection with the Examiner's Action. Reconsideration, withdrawal of the final action, and allowance of the application, as amended, is respectfully requested.

### **Objection to the Claims**

Claim 1 stands objected to because of informalities. In response, claim 1 has been amended to provide proper antecedent basis for "side" in connection with the "light-exit surface at a side of the cover facing away from the means for accommodating the at least one lamp." The objection is now believed overcome. Withdrawal of the objection to claim 1 is respectfully requested.

### **Rejection under 35 U.S.C. §102**

Claim 1 recites a luminaire comprising:

- a main reflector with a light emission window;
- a counter reflector positioned opposite to the main reflector;
- means for accommodating at least one electric lamp positioned in between the main reflector and the counter reflector,

characterized in that the counter reflector is provided with suspension means and a light-transmitting cover, wherein the suspension means comprises an outer edge of the counter reflector for connecting the light-transmitting cover to the counter reflector and further wherein the suspension means forms essentially an only contact between the counter reflector and the light-transmitting cover such that the light-transmitting cover is close to the counter reflector but not in optical contact with the counter reflector, and wherein the

light-transmitting cover is positioned at a side of the counter reflector facing away from the means for accommodating the at least one lamp, and which cover has a light-entry face exposed to the light emission window, and which cover has a light-exit surface at a side of the cover facing away from the means for accommodating the at least one lamp, wherein the cover further includes opaque diffuser bodies that are partly recessed in the cover at the side of the cover facing away from the means for accommodating the at least one lamp.

Support for the amendments to claim 1 can be found in the specification at least on page 2, lines 21-27; page 3, line 34; page 4, lines 1-3; and original claims 4-6 (now canceled).

Claims 1, 3, and 8-10 were rejected under 35 U.S.C. § 102(b) as being anticipated by Collins (4,755,916). With respect to claim 1, Applicant respectfully traverses this rejection for at least the following reasons.

The PTO provides in MPEP § 2131 that  
*"[t]o anticipate a claim, the reference must teach every element of the claim...."*

Therefore, with respect to claim 1, to sustain this rejection the Collins reference must contain all of the above claimed elements of the respective claims. However, the latter reference does not disclose "**opaque diffuser bodies** that are partly recessed in the cover at the side of the cover facing away from the means for accommodating the at least one lamp" as is claimed in claim 1.

In the office action on page 4, lines 13-15, the Examiner indicates that "Collins does not explicitly teach the cover further includes opaque diffuser bodies that are partly recessed in the cover at the side of the cover facing away from the means for accommodating the at least one lamp." [Emphasis added.] See also the office action at page 7, lines 5-7. Therefore, the 35 U.S.C. § 102(b) rejection of claim 1 is not supported by the Collins reference and should be withdrawn.

With respect to claims 3 and 8-10, the same depend from and further limit allowable independent claim 1 and therefore are allowable as well. Accordingly, claims 1, 3 and 8-10 are allowable and an early formal notice thereof is requested. The 35 U.S.C. § 102(b) rejection thereof has now been overcome.

### **Rejection under 35 U.S.C. §103**

Claims 1, 3-6 and 8-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Collins (4,755,916) in view of Azorin (6,536,909). With respect to claims 4-6, the same have been canceled herein, thus rendering the rejection thereof moot. With respect to claim 1, Applicant respectfully traverses this rejection on the grounds that these references are defective in establishing a prima facie case of obviousness.

As the PTO recognizes in MPEP § 2142:

*... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...*

It is submitted that, in the present case, the rejection is not factually supported by a prima facie case of obviousness for the following, mutually exclusive, reasons.

#### **1. Even When Combined, the References Do Not Teach the Claimed Subject Matter**

The Collins and Azorin patents cannot be applied to reject claim 1 under 35 U.S.C. § 103 which provides that:

*A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)*

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, since neither Collins nor Azorin teaches "... **suspension means** comprises an *outer edge* of the **counter reflector** for *connecting* the **light-transmitting cover to the counter reflector** and ... wherein the suspension means forms *essentially an only contact* between the counter reflector and the light-transmitting cover such that the **light-transmitting cover is close to ... but not in optical contact with the counter reflector ...**" as is claimed in claim 1, it is impossible to render the subject matter of claim 1 as a whole obvious, and the explicit terms of the statute cannot be met.

Thus, for this mutually exclusive reason, the burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

## **2. Prior Art That Teaches Away From the Claimed Invention Cannot be Used to Establish Obviousness**

In the present case, the Azorin reference, by providing a "layer made of a transparent material arranged in optical contact with a plane of the plate", requires the layer be disposed in optical contact with a surface of the plate (See Azorin Abstract lines 10-11 and also col. 2, lines 45-49). In contrast, the luminaire according to claim 1 provides that the "**light-transmitting cover is close to ... but not in optical contact with the counter reflector.**" Thus, the display backlight of Azorin clearly teaches away from claim 1, recited above.

Since it is well recognized that teaching away from the claimed invention is a *per se* demonstration of lack of *prima facie* obviousness, it is clear that the office action does not satisfy the burden of factually supporting any *prima facie* conclusion of obviousness.

Thus, for this reason alone, the burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should

be withdrawn.

### 3. The Combination of References is Improper

Assuming, arguendo, that none of the above arguments for non-obviousness apply (which is clearly not the case based on the above), there is still another, mutually exclusive, and compelling reason why the Collins and Azorin patents cannot be applied to reject claim 1 under 35 U.S.C. § 103.

§ 2142 of the MPEP also provides:

*...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.*

Here, neither Collins nor Azorin teaches, or even suggests, the desirability of the combination since neither teaches the specific "... **suspension means** comprises an outer edge of the **counter reflector** for connecting the **light-transmitting cover to the counter reflector** and ... wherein the suspension means forms essentially an only contact between the counter reflector and the light-transmitting cover such that the **light-transmitting cover is close to ... but not in optical contact with the counter reflector** ...", as specified above and as claimed in claim 1.

Thus, it is clear that neither patent provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection.

In this context, the MPEP further provides at § 2143.01:

*The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.*

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention,

absent some teaching, suggestion or incentive supporting the combination.

In the present case it is clear that the office action's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 1. Therefore, for this mutually exclusive reason, the office action's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

Accordingly, claim 1 is allowable and an early formal notice thereof is requested. Dependent claims 3 and 8-10 depend from and further limit independent claim 1 and therefore are allowable as well. Accordingly, the 35 U.S.C. § 103(a) rejection thereof has now been overcome.

Claims 2 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Collins and Azorin, and further in view of Ramer (6,334,700). This rejection is traversed for at least the following reason. With respect to claim 2, it depends from and further limits allowable independent claim 1 and therefore is allowable as well. With respect to claim 7, it depends from and further limits allowable claim 1 and therefore is allowable as well. Claims 2 and 7 are thus allowable and an early formal notice thereof is requested. The 35 U.S.C. § 103(a) rejection thereof has now been overcome.

Claim 11 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Collins and Azorin, and further in view of Staiger et al (5,065,287). This rejection is traversed for at least the following reason. With respect to claim 11, it depends from and further limits allowable independent claim 1 and therefore are allowable as well. Claim 11 is thus allowable and an early formal notice thereof is requested. The 35 U.S.C. § 103(a) rejection thereof has now been overcome.

### **Conclusion**

Except as indicated herein, the claims were not amended in order to address issues of patentability and Applicants respectfully reserve all rights they may have under the Doctrine of Equivalents. Applicants furthermore reserve their right to reintroduce subject matter deleted herein at a later time during the prosecution of this application or a continuation application.

It is clear from all of the foregoing that independent claim 1 is in condition for allowance. Dependent claims 3 and 7-11 depend from and further limit allowable independent claim 1 and therefore are allowable as well.

The amendments herein are fully supported by the original specification and drawings; therefore, no new matter is introduced. Withdrawal of the final action and an early formal notice of allowance of claims 1, 3 and 7-11 is requested.

Respectfully submitted,

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Dated: Oct. 15, 2007

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